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10/823,464	04/13/2004	Wayne Sicz	71043-002	4605

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EXAMINER

GARCIA, ERNESTO

ART UNIT PAPER NUMBER

3679

DATE MAILED: 01/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/823,464

Applicant(s)

SICZ ET AL.

Examiner

Ernesto Garcia

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) 12-19 and 21-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4-11 and 20 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 April 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>4/13/03</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election

This application contains claims directed to the following patentably distinct species of the claimed invention:

- I. Figs. 1-7.
- II. Figs. 8-16.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, there are no generic claims.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims

Art Unit: 3679

are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

dps During a telephone conversation with Mr. John Shakelford, Reg. # 36,003, on January 4, 2005 a provisional election was made with ^{oral} traverse to prosecute the invention of species I, claims 1-24, 31 and 32. Applicant in replying to this Office action must make affirmation of this election. Claims 12-19 and 21-32 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. Applicant had indicated that claims 12-21, 31 and 32 were generic. However, after careful review of claim 12, claim 12 does not read on the elected species as the endcap 132 is not attached to the distal end 84 of the projection 82. Instead, the endcap 132 is attached to the housing 130 (see Fig. 3 and paragraph 041 in line 6).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one

Art Unit: 3679

or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Drawings

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "80" has been used to designate both a foundation with an integral housing 130 (Figs. 2-6) and a foundation without a housing 130 (Figs. 8-10 and 12-15).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "82" has been used to designate both a projection of one configuration (Figs. 2-6) and a projection with another configuration (Figs. 8-10 and 12-14).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "132" has been used to designate both an endcap of one configuration (Figs. 2-5 and 7) and another endcap with another configuration (Figs. 8, 12-13 and 16).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference character "84" has been used to designate both a distal end of one configuration (Figs. 2 and 6) and another distal end with another configuration (Figs. 8-10).

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign "29" mentioned in the description of Figures 1-7 on page 6 in line 5. Note "29" appears on Figures 12 and 13 instead.

The drawings are objected to because reference character "86" points to a longitudinal line when it should point to the counterbore. Furthermore, the lead line of "94" in Figure 15 should not end with a circle as the circle is misleading or interpreted as a hole. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended". If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the

Art Unit: 3679

renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the examiner does not accept the changes, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because the description "cap screw holes 138 in the projection 82" in the last line of paragraph 041 is inconsistent with Figures 1-7. Instead, the cap screw holes 138 are in the housing 130. Appropriate correction is required.

Claim Objections

Claims 1, 5 and 9 are objected to because of the following informalities:

- regarding claim 1, --upper- needs to be inserted after "open" in line 4;
- regarding claim 5, --the- needs to be inserted after "wherein" in line 1; and,
- regarding claim 9, "said" in line 1 should be --a-- as a slide shoe has not been previously recited, and "slide" in line 1 should be --slider-- to be consistent with the description of feature 140. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cienfuegos, 5,044,592, in view of Bowerman, 3,596,958.

Regarding claim 1, Cienfuegos discloses, in Figure 2, an adjustable bicycle seat post assembly comprising an outer seat tube **12**, an inner seat post **18**, a spring (unlabeled but shown near 12), and a latch member **28**. The tube **12** has an open upper end and an opposite lower end. The post **18** has a lower end telescopically received in the upper end and an opposite upper end. The spring is housed within the tube **12** and acting with a constant spring force between the tube **12** and the post **18**. The latch member **28** is carried by the tube **12**. Applicant is reminded that the latch member **28** is able to engage with the post **18** when in a latched condition for selectively locking the post **18** in one of at least two positions of adjustment relative to the tube **12**. However, Cienfuegos fails to disclose a magnetic switch operative to move the latch member **28**. Bowerman teaches, in Figures 1 and 2, a magnetic switch **28, 38, 40** for moving a latch member **20,22** to lock two relatively slidable members in a selected

Art Unit: 3679

position (col. 2, lines 58-61). Therefore, as taught by Bowerman, it would have been obvious to one of ordinary skill in the art at the time the invention was made to include a magnetic switch to replace the locking mechanism comprised of the latch member.

Regarding claim 2, the switch magnet **28, 38, 40** includes a pair a pair of switch magnets **38, 40** of opposite polarity.

Regarding claim 3, the magnetic switch **28, 38, 40** includes a switch housing supporting the switch magnets **38,40**.

Allowable Subject Matter

Claims 4-11 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

regarding claim 4, the prior art of record does not disclose or suggest an adjustable bicycle seat post assembly comprising a latch member moving under the influence of a changing magnetic field in response to moving switch magnets.

Bowerman teaches a pair of switch magnets that do not move but instead uses a bar magnet to move the latch member; and,

regarding claims 5-11 and 20, these claims directly or indirectly depend from claim 4.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 9:30-6:00. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on 703-308-2686. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

Art Unit: 3679

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



E.G.

January 6, 2005



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